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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,987	01/11/2001	Marc De Beuckeleer	514412-2025	2496

7590

03/26/2002

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EXAMINER

SOUAYA, JEHANNE E

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 03/26/2002

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/758,987

Applicant(s)
DeBeuckeleer

Examiner
Jehanne Souaya

Art Unit
1634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 11, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 16-18, and 26-27, drawn to a method for identifying elite event GAT ZM1 and methods for confirming seed purity and screening seeds for the presence of GAT ZM1, classified in class 435, subclass 6.
 - II. Claims 8-15, and 19-25, drawn to nucleic acids for identifying elite event GAT ZM1 and kits comprising the nucleic acids, classified in class 536, subclass 23.1.
2. The inventions are distinct, each from the other because of the following reasons: The inventions of groups I and II are patentably distinct as the nucleic acids of group II can be used to identify sequences other than those associated with GAT-ZM1. For example, the primer of SEQ ID NO 12 is complementary to the CaMV promoter which is not specific to GAT ZM1. Further, some claims to nucleic acid sequences do not recite any structure, that is no specific nucleic acid sequence, while others recite only 80% homology, without any hybridization or specific PCR conditions. Such recitations encompass sequences that are not specific to GAT-ZM1. Also, claims that do not recite a specific nucleic acid sequence encompass a single nucleotide base, which is not specific for GAT ZM1. It is noted that some claims are drawn to sequences that recognize a sequence of SEQ ID NO 6 and 10, however these sequences encompass regions that contain partial sequences from the plant genome, which are not specific to GAT ZM1. Therefore, without the recitation of hybridization or PCR conditions, and with regard to some

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claims which lack any structural limitation, the nucleic acids in Group II are not specific for the methods of identifying GAT ZM1 of group I.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Souaya whose telephone number is (703)308-6565. The examiner can normally be reached Monday-Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jehanne Souaya

Jehanne Souaya
Patent examiner
Art Unit 1634

3/20/02